



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,229	08/31/2000	Thomas E. Saulpaugh	5181-6330	4610

7590 04/20/2004
Robert C Kowert
Conley Rose & Tayon PC
P O Box 398
Austin, TX 78767-0398

EXAMINER

MANIWANG, JOSEPH R

ART UNIT	PAPER NUMBER
----------	--------------

2144

DATE MAILED: 04/20/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/653,229

Applicant(s)

SAULPAUGH ET AL.

Examiner

Joseph R Maniwang

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-17,19-34 and 36-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-17,19-34 and 36-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1, 3-17, 19-34, and 36-43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 09/693,673. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of

Art Unit: 2144

the current application are directed to a method and system employing a message gate that processes messages sent between a client and a service for verifying adherence to a data representation language schema and authentication credentials. The claims of copending App No. 09/693,673 are directed to a method and system for communicating messages between a client and a "respective paired message gate at another device", which included a service (see claim 1 and 8). This was achieved through a plurality of message gates configured for sending and receiving messages in a data representation language, and further configured to verify adherence to a data representation language schema and authentication credentials (see claims 2-7). Furthermore, both applications claim the use of XML (compare present claim 15 and App No. 09/693,673 claim 5). The present claims describing a message gate would have been obvious in light of the claims of App No. 09/693,673 since they describe a system with a plurality of such gates for performing similar functions. A system implementing a message gate unit as claimed would have been obvious in light of the claims describing a system with a plurality of such message gates.

2. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments/Reasons for Allowance

Applicant's arguments, see Paper No. 9, filed 02/02/04, with respect to the rejection(s) of claim(s) 1-43 under 35 U.S.C. 102(a) and 35 U.S.C. 103(a) have been fully considered and are persuasive. The combination of the claimed limitations of

Art Unit: 2144

generating a message endpoint according to a data representation language schema defining a message interface using a subset of all messages that can be handled by the service in combination with the provision for client side verification of a message according to the data representation language schema and authentication of credentials attached to the message by the endpoint is not fairly taught or suggest by the prior art of record.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hill et al. (U.S. Pat. No. 5,511,197) disclosed a method and system for passing a pointer to an interface from a server process to a client process.

Mitchell et al. (U.S. Pat. No. 6,356,933) disclosed a method for transferring application data between a client and a server in a markup language.

Wei (U.S. Pat. No. 5,701,415) disclosed a method for creating stub files with common procedure code, used for making remote procedure calls in a network.

Brown et al. (U.S. Pat. No. 4,736,321) disclosed a method for executing remote processes by establishing a message interface.

Box et al. ("Simple Object Access Protocol (SOAP) 1.1", W3C Note, 08 May 2000) disclosed a protocol for exchanging information in a distributed environment based on XML and encoding rules.

This application is in condition for allowance except for the following formal matters:

A double patenting rejection made in the application of claims 1, 3-17, 19-34, and 36-43, as the claims are not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R Maniwang whose telephone number is (703) 305-3179. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B Harvey can be reached on (703)305-9705. The fax phone number for the organization where this "application or proceeding is assigned is 703-872-9306.

Art Unit: 2144

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

MARC D. THOMPSON
MARC THOMPSON
PRIMARY EXAMINER